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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,770	04/11/2001	Carlos De La Huerga	250591.90279	2242

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EXAMINER	
MISKA, VIT W	

ART UNIT	PAPER NUMBER
2833	

MAIL DATE	DELIVERY MODE
01/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/832,770	DE LA HUERGA, CARLOS	
	Examiner	Art Unit	
	Vit W. Miska	2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5,7-10 and 12-153* is/are pending in the application.

4a) Of the above claim(s) *41-106 and 109-153* is/are withdrawn from consideration.

5)☒ Claim(s) *1,4,5,7-10,12-40* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claim 107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn (5774865).

The reference discloses an apparatus and method for performing health safety functions including containers 1,2,4 for holding doses of medication, machine readable and writable memory strips 3,5,7, respectively, containing specifying information (medicine identity, col. 4, line 38) usable to determine a prescribed dosing regimen (col.4, line 57-58), sensor 13 with sensor area 9 for receiving several specifying devices 3,5,7 receiving the specifying information, sensor 13 linked to processor 21 (Fig. 4B), using the information to identify a prescribed dosing regimen (col. 5, line 18), and performing a health safety function (alarm reminders, col. 5, line 29).

The specifying information is disclosed as being at least the identity of the medication (col. 4, line 38). Processor 21 stores dosage regimens for each of the medications (col. 4, line 58, col. 5, line 18.

2. Glynn suggests the specifying information or medicine identity information of the medication containers on the tray is first input into the RAM of the microprocessor by the user (col. 4, lines 32-56 and col. 5, lines 16-22) by placing the containers for the first time on the tray (col. 4, lines 40-41) and scanning by scanner 13. Medication that is not already stored in the RAM and not recognized is manually input via a keyboard (col. 4, lines 43-48). However, whether the specifying information is stored in the RAM by the user scanning the containers or is programmed therein prior to use of the device would be a matter of obvious choice to the designer. Glynn apparently scans the containers to determine which and how many medications are present in the tray. If sufficient memory space were available in the RAM, then one of ordinary skill in the art would recognize that all medication and dosage information could be stored therein prior to and without the need of the user inputting such data. The size and cost considerations of the device of Glynn will dictate to one skilled in the art how much data may be stored in RAM 47.

3. Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn in view of Mucciacciaro. With respect to the separate sensing areas, Glynn suggests separate sensors positioned under each container (col. 6, line 46). Regarding separate visual indicators for the medication containers, It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in

the Mucciacciaro device at 12, 24 as an obvious means for prompting the user to take the medication in the correct container.

Response to Arguments

4. Applicant's comments with respect to claim 107 have been carefully considered but have not been found persuasive.

5. Applicant appears to imply that claim 107 requires prescription information to be automatically obtained from the specifying device. However, the pertinent claim language includes: "(i)receiving the specifying information a first time from the specifying device; (ii) using the specifying information to identify prescribed dosing regimen information". Thus, claim 107 requires the "specifying information" (not prescription information or dosing regimen) to be received for the first time and thereafter "using the specifying information" to identify the regimen. The medication information read from the container specifying device in Glynn corresponds to the claimed "specifying information". The medication information is subsequently used by the Glynn device to identify the dosing regimen (col. 5, line18), as claimed.

6. Whether the medication information (specifying information) is initially entered by the user, or is read from the container memory device and correlated with pre-stored data in the CPU memory, is considered obvious for the reasons set forth in par. 2, above.

7. Claims 1 and 22 are allowable. The restriction requirement among species, as set forth in the Office action mailed on 2/26/2004, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 12-21, 30-35, and 37-40 are directed to species no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim. However, the remaining withdrawn claims, directed to non-elected species are withdrawn from consideration because these claims do not require all the limitations of an allowable claim.

8. In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

9. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

10. Claims 1, 4-5, 7-10, 12-21, 15, 17, 22-40 are allowed, subject to claims 12,14 and 16 being corrected to depend from a pending claim.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on 571-272-2009. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vit W. Miska/
Primary Examiner, Art Unit 2833